

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed March 9, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 101

Claims 1-13 and 29-34 have been rejected under 35 U.S.C. § 101 for purportedly being directed to non-statutory subject matter. Applicant respectfully disagrees, but in a good faith effort to advance prosecution, however, Applicant has amended independent claim 1 to recite a “program stored on a non-printed, tangible computer-readable medium”. Applicant respectfully submits that this subject matter complies with 35 U.S.C. § 101, and therefore respectfully requests that the rejection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-34 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lin (U.S. Pub. No. 2003/0052897). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office (“USPTO”) has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, the prior art at least does not teach or suggest all of the claim limitations. Applicant discusses the Lin reference and Applicant's claims in the following.

A. The Lin Reference

Lin discloses a system for providing multimedia photo albums. More particularly, Lin describes a system with which still pictures may be stored as part of a photo album and video signals can be combined with the still images. Lin, paragraph 0025, lines 1-6; paragraph 0026. Furthermore, audio signals can be can also be added to the still and video images. Lin, paragraph 0030, lines 1-4.

With the availability of this various data, the user can manually create a photo album. As is described by Lin:

A number of conventional editing or display functions can be performed at the picture processor 180 upon command by the control CPU 122. For example, the still images or the associated video can be enlarged or reduced, pictures can be merged, split or deleted and

multiple pictures can be processed for simultaneous display. In addition, the picture processor 180 can facilitate *creation of a slide show presentation by the user*. It is understood, however, that the invention is not limited in this regard, as many other display and editing functions can be performed by picture processor 180.

[Lin, paragraph 0034, lines 7-14 (emphasis added)]

In addition, Lin states:

Each VOBS 30 can include one or more video objects (VOB) 32. For purposes of the invention, each VOB 32 can be referred to as a picture group (PG). In one arrangement, each VOB 32 can have a menu for PG 33, which can list all the cells 34 that are contained within a particular VOB 32. For purposes of the invention, each cell 34 can be referred to as a picture set (PS). Similar to the VOB's 32, each cell 34 can have a menu for PS 35, which can list all the picture units (PU) 37 contained within a particular cell 34. *These PU's 37 can be listed in the menu for PS 35 according to the name created for each particular PU 37 during the writing process as discussed in FIG. 1.* As a result, a user is permitted direct access to any PU 37 that is stored on the disc 102 as part of a DVD photo album and is not limited to access data at the cell 34 layer.

[Lin, paragraph 0049]

From the above two excerpts, and the remainder of the Lin disclosure generally, it is clear that, although the Lin system facilitates creation of a multimedia photo album *by a user*, the Lin system *cannot* and does *not* “automatically” create any photo album or other “presentation”.

B. Applicant's Claims

Applicant claims programs, systems, and methods for creating a multimedia presentation in which an initial presentation is *automatically* composed for the user. For example, as provided in independent claim 1, Applicant claims (emphasis added):

1. A program stored on a non-printed, tangible computer-readable medium, the program for composing a multimedia presentation from a plurality of media elements, the plurality of media elements including audio media elements and image elements, the image elements including at least one still image, the program comprising logic configured to:

determine at least one control setting, the control setting including the duration time for display of the at least one still image in an initial presentation; and

automatically compose the initial presentation, the initial presentation including the plurality of media elements, the initial presentation based in part on the duration time for the at least one still image and the initial presentation *based in part on at least one time stamp associated with at least one of the media elements*.

As is noted above, Lin does not disclose any program, system, or method that *automatically* composes an initial presentation. Indeed, it is clear from Lin's disclosure that nothing in the Lin system *automatically* composes any presentation. Accordingly, Lin fails to teach logic configured to "automatically compose an initial presentation" as required by in claim 1. Applicant further notes that since Lin says nothing about such automatic composition, it follows that Lin also does not suggest such an aspect. Furthermore, Wolff also fails to teach or suggest such a feature. As was indicated in the previous Response, independent claims 14 and 18 comprise similar recitations.

As a further point, Applicant notes that Lin does not enable a user to compose an initial presentation that is “based in part on the time of recording of the plurality of media”. Although Lin makes a brief reference to “when the file was created” (Lin, paragraph 0056, lines 7-10), *nowhere* does Lin state that such a time is used as a basis for composing a presentation. Accordingly, Lin fails to teach or suggest composing an initial presentation “based in part on at least one time stamp associated with the at least one of the media elements” as provided in claim 1. Again, independent claims 14 and 18 comprise similar recitations.

As to the Examiner’s argument that Lin inherently teaches arranging a presentation that is based in part on the time of recording of the plurality of media, Applicant disagrees that a photo album is a presentation that must be arranged in temporal order. Although some photo albums are arranged in chronological order, this is not always true. Given this fact, it follows that creation of Lin’s photo album does *not* inherently involve arranging a presentation that is based in part on the time of recording of the plurality of media.

Regarding the Wolff disclosure, Applicant first notes that, irrespective as to what Wolff teaches in relation to arranging photographs by date stamp, Wolff still does not teach automatically composing a presentation in the manner described in claim 1, or claims 14 and 18 for that matter. Moreover, it is clear that Wolff does not teach or suggest arranging still images *with* video in chronological order.

C. Conclusion

In summary, it is Applicant’s position that a *prima facie* for obviousness has not been made against Applicant’s claims. Therefore, it is respectfully submitted that each

of these claims is patentable over the Lin reference and that the rejection of these claims should be withdrawn.

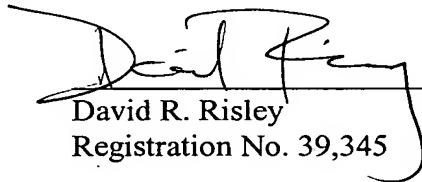
III. New Claims

As identified above, claims 35-48 have been added into the application through this Response. Applicant respectfully submits that these new claims describe an invention that is clearly novel and unobvious in view of the prior art of record and, therefore, respectfully requests that these claims be held to be allowable.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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6/9/05

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